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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,175	04/09/2001	Maurizio Lazzerini	34748/GM/1p	7483

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EXAMINER

FULLER, ERIC B

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 10/07/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/828,175

Applicant(s)

LAZZERINI, MAURIZIO

Examiner

Eric B Fuller

Art Unit

1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 September 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see detailed action

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: it is based on amendments that have not been entered.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-12.

Claim(s) withdrawn from consideration: 13-16.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant's amendment has not been entered because it would raise new issues. For example, the limitation of the covering layer further comprising ink (claim 2) would be dependent from a claim that reads that the covering layer comprises a magnetic layer (claim 1). This combination of limitations was absent from currently pending claims 1-16, and therefore would require further search and consideration.

Response to Arguments

Applicant argues that the limitations to claim 5 are not met by the prior art made of record. Applicant shows how each reference individually fails to anticipate the claimed invention. However, it is noted that the prior art used in the rejection of claim 5 was cited in combination with each other.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that Meyer teaches magnetic layers for data storage and therefore no person skilled in the art of security elements would ever read or search for

Art Unit: 1762

a publication concerning hard disks in order to find suggestions for a security element.

This argument is not found convincing.

In response to applicant's argument that Meyer is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

As to claim 5, it has been shown in previous actions that Harbough in view of Hutton teach the limitations of claim 1. Specifically, a polyester backing-layer is coated with a coating-layer and a laser is used to ablate areas of the coating-layer such that a security element is formed. Examiner concedes that Harbough in view of Hutton fails to teach that the coating layer may be magnetic. To make up for this deficiency, the examiner has cited Mantegazza as teaching that by having the coating-layer in security elements be made of a magnetic coating, the layer can hold more coding information, the information can be machine read, the layer is non-optical, and the code is all but impossible to fraudulently reproduce. Therefore, one of ordinary skill in the art would realize the benefits of using a magnetic coating-layer in the process taught by Harbough in view of Hutton. One of skill would now question if the use of a magnetic coating is possible in the process of Harbough in view of Hutton, i.e. if the magnetic layer is laser ablatable (as Harbough in view of Hutton requires the coating-layer to be). The knowledge that magnetic coatings are laser ablatable is needed in order for one of ordinary skill to have an expectation that using a magnetic coating in the process taught

by Harbough in view of Hutton would succeed. Mantegazza, alone, fails to teach that magnetic coatings are laser ablatable. Therefore, one of skill in the art, if not previously known, would have the motivation to find out if magnetic coatings are laser ablatable, such that the combination of Mantegazza with Harbough and Hutton may be implemented.

It is the position of the examiner that one of ordinary skill would have the motivation to search for and read any reference that provided validation of magnetic coatings being laser ablatable such that an expectation of success is achieved. One would have motivation to search in class 427/555, which is delegated for laser ablation of coatings. In this class, Meyer is found. Meyer teaches that it is well known to use laser ablation in order to remove areas of a magnetic coating. Therefore, Meyers is utilized as providing an expectation of success for the process that is all ready made obvious by Harbough in view of Hutton in further view of Mantegazza.

Additionally, examiner notes that the magnetic coating used in Mantegazza and the magnetic layer in Meyer function in a similar manner. Both are made up of areas of magnetic coating and blanks and both are used to hold information that is machine-readable. Therefore, these references are considered analogous.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B Fuller whose telephone number is (703) 308-6544. The examiner can normally be reached on Mondays through Thursdays.

Art Unit: 1762


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck, can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



EBF

October 2, 2002



TIMOTHY WEEKS
PRIMARY EXAMINER